

## **REMARKS**

### **INTRODUCTION**

Claims 1-28 were previously and are currently pending and under consideration.

Claims 1-28 are rejected.

No claims are amended herein.

No new matter is being presented, and approval and entry are respectfully requested.

Regarding the following arguments concerning the prior art rejections, even if new grounds of rejection are found, "[t]he examiner must, however, address any arguments presented by the applicant which are still relevant to any references [still] being applied" (MPEP § 707.07(f)). Applicant respectfully requests a response to each of the following arguments that may remain relevant with respect to Adamson, Annsberry, Tung, and so on.

### **REJECTIONS UNDER 35 USC § 102**

In the Office Action, at pages 2-6, claims 1-2 and 11 were rejected under 35 U.S.C. § 102 as anticipated by Adamson. This rejection is traversed and reconsideration is requested.

Claim 1 recites "generating a list describing indication means operable at both the destination user's information terminal and the source user's information terminal", and "recording the list to the source user before communication begins".

The rejection compares claim 1's generation of a list with column 8, lines 28-31 of Adamson. The rejection, at page 3, item (c), summarizes the cited portion of Adamson as describing a list that is generated after the conferencing system determines which transport types are supported by each user on the conferencing system.

Applicant respectfully traverses this aspect of the rejection for the two following reasons.

First, the rejection's characterization of Adamson is incorrect. Column 8, lines 28-31 of Adamson, states that "connection function further queries independent transport service 34 to interrogate the transport hardware to detect the transport types supported on a PC conferencing

system". Although this portion of Adamson refers to the conferencing *system*, it is clear from the entire Adamson reference that what is being described at lines 28-31 is a list of transport types supported by the hardware on the particular *PC* running the conferencing application initiating a call; the term "system" at lines 28-31 is an error in Adamson. Column 6, lines 1-3 describe transport services 34 as a component of the conferencing application 22, and the conferencing application 22 runs independently on each PC participating in the conferencing system. It would not make sense for the conferencing application 22 to display a list of transport types supported in the overall system or at each PC. Column 1, lines 60-62 notes that different users may have different transport capabilities. The cited portion refers to hardware on a PC. Furthermore, Figure 1 of Adamson shows that different PCs within the same conferencing system may have different transport protocols available. For example, PC 12a may have an ISDN and a PSTN connection, PC 12g may have a LAN connection and a PSTN connection but not an ISDN connection, etc. Finally, it appears that the transport type selection mechanism described in Adamson is intended to match an available transport mechanism on the caller's PC with an identical transport mechanism or protocol available on the callee's PC. In sum, the transport type display area 278 in Adamson is a list of communication means operable only on the hardware of the source user's information terminal/PC. It is not a list of transports supported by each user on the conferencing system (as stated in the rejection) and it is not a list describing communication means operable at both the destination user's information terminal and the source user's information terminal.

Second, even if for the sake of discussion the rejection's characterization of Adamson as providing a list of transport types supported by each user on the conferencing system were correct, a list of transport types supported by each user on the conferencing system is not the same as a list describing communication means operable at both the destination user's terminal and the source user's terminal. The generated and reported list recited in claim 1 describes communication means operable at both the source and destination terminal. If transport types listed in the pulldown list 278 in Adamson were known to be operable at both the source and destination terminal, then there would be no reason for the connection function of Adamson to "determine[] if the matched addressee's preferred transport type is supported, step 234" (col. 8, lines 63-65).

Withdrawal of the rejection of claim 1 is respectfully requested. Claims 2 and 11 recite "generating a list... describing communication means actually usable by both source users and destination users", and "reporting the generated list to source users before communication begins". Withdrawal of the rejection of claims 2 and 11 is respectfully requested.

### **REJECTIONS UNDER 35 USC § 103**

In the Office Action, at pages 6-7, claim 3 was rejected under 35 U.S.C. § 103 as being unpatentable over Adamson in view of Pickering and Cloutier.

Claims 4-6 were rejected under 35 U.S.C. § 103 as being unpatentable over Adamson in view of Pickering and Cloutier and further in view of Minnick.

Claim 10 was rejected under 35 U.S.C. § 103 as being unpatentable over Adamson in view of Lee.

Claims 12-13 and 16 were rejected under 35 U.S.C. § 103 as being unpatentable over Adamson in view of Tung and Ansberry.

Claims 14-15 and 17-18 were rejected under 35 U.S.C. § 103 as being unpatentable over Adamson-Ansberry-Tung and further in view of Morris.

Claims 7, 9, 19-20 and 27-28 were rejected under 35 U.S.C. § 103 as being unpatentable over Adamson in view of Pickering.

Claim 8 was rejected under 35 U.S.C. § 103 as being unpatentable over Adamson-Pickering in view of what was well known in the art.

Claims 21-22 and 24 were rejected under 35 U.S.C. § 103 as being unpatentable over Adamson in view of Pickering and Cloutier and further in view of Minnick.

Claim 23 was rejected under 35 U.S.C. § 103 as being unpatentable over Adamson in view of Pickering, Cloutier and Minnick and further in view of Avidan.

Claims 25 and 26 were rejected under 35 U.S.C. § 103 as being unpatentable over Adamson-Pickering-Cloutier-Minnick and further in view of Morris.

Independent claims 12, 17, 19, and 28 recite a list describing communication means operable at both the source terminal and the destination terminal. The obviousness rejection cites only Adamson as adding these features to the cited combination. The rejection of claims 12, 17, 19, and 28 is traversed based on the distinctions over Adamson discussed above with reference to claims 1, 2, and 11. Withdrawal of the rejection is respectfully requested.

Claim 3 was rejected in further view of Pickering and Cloutier. Pickering discusses an interactive directory stored on a server and displayed on a personal computer via a network. The interactive directory lists the names of various persons, together with telephone numbers at which they can be contacted and the current status of each person (e.g. busy, out of the office etc.). If one of the telephone numbers listed in the directory is an Internet telephone, then a user can click on the number to connect with that person. Pickering was cited as providing claim 3's statuses of communication means actually usable on a user's terminal. However, the communication means recited in claim 3 are communication means operable in a same given terminal (see parent claim 2). The statuses in Pickering are single statuses of different individual terminals; telephone terminals. This is not the same as multiple actual-usability statuses of a single terminal. Cloutier was not cited as providing this feature. Withdrawal of the rejection of claim 3 is respectfully requested.

Claims 12 was rejected as obvious over Adamson in view of Tung and Annsberry. The rejection cites Tung as adding to the cited combination means for applications to be downloaded onto a PC when that PC does not have the application necessary for communication with another PC. This interpretation of Tung is respectfully traversed. The cited portion of Tung discloses only that a "conference manager" can order an application to be installed on a PC. Tung does not mention downloading the application or how it might be performed. Withdrawal of the rejection of claims 12, 13, and 16 is further respectfully requested.

**PRIMA FACIE CASE OF OBVIOUSNESS NOT MET: MOTIVE NOT FOUND IN THE PRIOR ART**

The rejection provided various reasons for combining the prior art references. The motive on page 7 is not found in the prior art and no prior art reference is cited as providing the motive. The motives on page 8, 9, 11, 13-16, 21, 22 also mention that it would have been obvious "in order to ...", "to allow ...", etc. MPEP § 2144.08 states that "Where applicable, the

[Examiner's] findings should clearly articulate which portions of the reference [not combination] support any rejection. Explicit findings on motivation or suggestion to select the claimed invention should also be articulated in order to support a 35 U.S.C. 103 ground of rejection ... Conclusory statements of similarity or motivation, without any articulated rationale or evidentiary support, do not constitute sufficient factual findings." Furthermore, Ex parte Obukowicz, 27 USPQ 2d 1063, 1065 (B.P.A.I. 1992) states that "The examiner can satisfy this burden [of showing obviousness] only by showing some objective teaching *in the prior art* ... would lead that individual to combine the relevant teachings of the references." The motives provided in support of the cited combinations are not motives found *in the uncombined prior art* that indicate why one would want to make the combination. The cited advantages of the proposed combinations are at best advantages that might or might not exist after the combination has been made; the combination itself may not be the source of a motive to combine references.

## **DEPENDENT CLAIMS**

The other dependent claims are deemed patentable due at least to their dependence from allowable independent claims. These claims are also patentable due to their recitation of independently distinguishing features. For example, claim 8 recites that "designation means is enabled to receive a destination-user's designation according to identification information specifying operable communication means at destination users' information terminals". This feature is not taught or suggested by the prior art. Withdrawal of the rejection of the dependent claims is respectfully requested.

## CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450  
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